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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,129	11/07/2000	David N. Spiegel	END920000101US1	1094

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EXAMINER

RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/708,129	SPIEGEL, DAVID N.
	<b>Examiner</b>	<b>Art Unit</b>
	J. Derek Ruttent	2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 07 November 2000 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-18 is/are rejected.

7)  Claim(s) 6 and 14 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 07 November 2000 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

1. Claims 1-18 have been examined.

### *Drawings*

2. This application, filed under former 37 CFR 1.60, lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings. In unusual circumstances, the formal drawings from the abandoned parent application may be transferred by the grant of a petition under 37 CFR 1.182.

### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Software Maintenance with Automatic Dependency Resolution.

4. The use of the trademark IBM has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Objections*

5. Claims 6 and 14 are objected to because of the following informalities: The phrase "is a service link" as used in the claims appears in the specification as referring to a computer software product. The examiner has interpreted this phrase as referring to that product which is referred to in the objection to the disclosure above, and as such it should be capitalized and reworded in the claims as --is Service Link--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,960,189 to Stupek et al.

Regarding claim 1, Stupek discloses

*A method of maintaining software on a computer system comprising the steps of:*

*Bringing up first and second host sessions on a computer system (e.g. computer environments for starting a software upgrade application);*

*Starting in said first host session, a software recording application having data on first maintenance items applied to said computer system (figure 1 reference 5 "Management Information Base", column 3 lines 22-30, "A management information*

base (MIB) within the server maintains basic descriptive information about each of the resources available on the server.”);

*Starting in said second host session, a database application having a database of second maintenance items including prerequisite items and corequisite items corresponding to each of said second maintenance items* (figure 1 reference 9 “Upgrade Database”, column 7 lines 8-10, “The database also contains information regarding the dependencies between the package and other upgrade objects or packages...”);

*Activating a maintenance application on said computer system* (figure 1 reference 11 “Upgrade Advisor”);

*Entering a first list of third maintenance items in said maintenance application* (figure 1 reference 7 “Resource Upgrades”, column 3 lines 31-43, “Upgrades to the network resources are provided to a server manager by a distribution medium...”);

*Searching said database for said prerequisite items and corequisite items corresponding to each of said third maintenance items on said first list, and adding said corresponding prerequisite items and corequisite items to said first list* (column 4 lines 35-44, “An agent of the server manager located in the server uses this information to search for the resource...the server manager creates entries for the resource in the server database”, where the server database keeps information about the Management Information Base [MIB]);

*Thereafter determining from said software recording application which items on said first list have already been received, and adding those items not received to an order list* (column 4 lines 19-26, column 5 lines 41-47, “The upgrade advisor then retrieves

upgrade information from the upgrade database and performs two types of comparisons:

...b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource..."); and

*Ordering, receiving, and applying said items on said order list* (column 5 lines 48-63, "When the job is ready to be installed to the target server, the server upgrader connects with the server... and then sends the job... to a staging area. The staging area may... be anywhere else in the network capable of handling the deposit and retrieval of upgrade files....the agent executes the instructions in the control file...").

Regarding claim 3, Stupek et al discloses the use of an operating system with the computer system (column 1 line 17).

Regarding claim 4, Stupek et al discloses the use of a network with the computer system (column 1 line 13).

Regarding claim 5, Stupek et al discloses the practice of keeping track of what software has been installed or uninstalled (column 6 lines 45-47).

Regarding claim 6, Stupek et al disclose the use of a database application through the use of the "server database" (column 4 lines 14-16).

Regarding claim 7, Stupek et al discloses the practice of storing information relating to program updates in a file (column 6 lines 43-45).

Regarding claim 8, Stupek et al discloses the practice of updating software on the computer system (column 5 lines 48-63).

Regarding claims 9, 17, and 18, they are product versions of the process claimed in claim 1 and are rejected for the reasons set forth in the rejection of claim 1.

Regarding claims 11-16, they are product versions of the process claimed in claims 3-8, respectively, and are rejected for the reasons set forth in the above rejection of those claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stupek et al as applied to claim 1 above, and further in view of "Y2K Compliance and the Distributed Enterprise" by Gowan et al.

Regarding claim 2, Stupek et al teaches a system for software maintenance. Stupek does not specifically teach software maintenance on a mainframe. Gowan et al teaches the benefits of upgrading a mainframe computer system. It does not teach upgrading a mainframe using a software maintenance system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Stupek's software maintenance system with Gowan's concept of upgrading a mainframe computer in order to facilitate a swift and automated upgrade process. This is desirable since mainframe computers serve a large number of users, and having a swift and automated upgrade process ensures the availability of correct and efficient software.

Regarding claim 10, it is a system version of the process of claim 2, and is rejected for the reasons set forth in the rejection of claim 2 above.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,933,646 to Hendrickson, Scown, Palmer, Bowers, and Cobb discloses a software manager including several databases and an installer.

U.S. Patent No. 5,617,533 to Wu, McCall, Raney, and Wu discloses a software auditing system which reads configuration files specifying installation packages and rules.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (703)605-5233. The examiner can normally be reached on M-F 6:30-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5484.

jdr  
July 31, 2003

*M-2*  
WEI 2H6W  
Patent Examiner  
TC 2100